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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 10/747,624  | 12/30/2003  | Noel Enete           | 06975-387001 /<br>Communicat | 2829             |
| 26171   | 7590        | 02/26/2007           | EXAMINER                     |                  |
| FISH & RICHARDSON P.C.<br>P.O. BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      | HAMZA, FARUK                 |                  |
|   |             |                      | ART UNIT                     | PAPER NUMBER     |
|   |             |                      | 2155                         |                  |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 02/26/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/747,624

Applicant(s)

ENETE ET AL.

Examiner

Faruk Hamza

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/12/04</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to the application filed on December 30, 2003.  
Claims 1-22 are pending.

### ***Drawings***

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings filed on December 30, 2003 contain hand written labeling. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 12 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specification failed to provide antecedent basis for "computer readable medium" recited in claims 12 and 17, it appears that signal is not limited to tangible embodiment, therefore non-statutory.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S.

patent resulting directly or indirectly from an international application filed before

November 29, 2000. Therefore, the prior art date of the reference is determined

under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C.

102(e)).

4. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashemi (U.S. Pub. No. US 2003/0212804) hereinafter referred as Hashemi.

Hashemi teaches the invention as claimed including method for sharing of media clips, such as sound and video, among various computer systems without the sharing of the corresponding media clip files (See abstract).

As to claim 1, Hashemi teaches a computer implemented method for regulating a level of self-disclosure in an instant messaging communications session, the method comprising:

enabling user selection on a first instant messaging participant system of an instant messaging communications mode from among at least a first available mode and a second available mode, the first available mode disclosing a different amount of information about a first instant messaging participant than the second available mode (P[0021-0027], P[0046-0047], Fig. 2, Hashemi discloses audio and video mode);

enabling creation of a message clip on the first instant messaging participant system according to the selected communications mode (P[0021-0027], P[0046-0047], Hashemi discloses recording and storing clip); and

enabling delivery of the message clip from the first instant messaging participant system to a second instant messaging participant system (P[0021-0027], P[0046-0047], Hashemi discloses streaming clip to other peers).

As to claim 2, Hashemi teaches the method of claim 1 further comprising storing the message clip on a host system (P[0021]).

As to claim 3, Hashemi teaches the method of claim 2 wherein enabling delivery comprises enabling delivery of the message clip from the host system to the second instant messaging participant system (P[0046-0047]).

As to claim 4, Hashemi teaches the method of claim 1 further comprising:

selecting the first available mode (P[0021-0027]);

creating a first message clip on the first instant messaging participant system according to the first available mode (P[0021-0027]); and

delivering the first message clip from the first instant messaging participant system to the second instant messaging participant system (P[0046-0047]).

As to claim 5, Hashemi teaches the method of claim 4 further comprising:

selecting the second available mode (P[0021-0027]);

creating a second message clip on the first instant messaging participant system according to the second available mode (P[0021-0027]); and

delivering the second message clip from the first instant messaging participant system to the second instant messaging participant system (P[0046-0047]).

As to claim 6, Hashemi teaches a computer implemented method for regulating a level of self-disclosure in an instant messaging communications session, the method comprising:

rendering, on a first instant messaging participant system, an instant messaging application user interface for an instant messaging communications session involving at least a first instant messaging participant and a second instant messaging participant (Fig. 2, P[0046-0047], Hashemi discloses chat (instant messaging) system);

enabling user selection on the first instant messaging participant system of an instant messaging communications mode from among at least a first available mode and a second available mode, the first available mode disclosing a different amount of information about the first instant messaging participant than the second available mode, the user selection being enabled at least in part through display of the available modes at the instant messaging application user interface (P[0021-0027], P[0046-0047], Fig. 2, Hashemi discloses audio and video mode);

enabling creation of a message clip on the first instant messaging participant system according to the selected communications mode, the message clip being created at least in part through user interaction with the instant messaging application user interface (P[0021-0027], P[0046-0047], Hashemi discloses recording and storing clip); and

enabling delivery of the message clip from the first instant messaging participant system to a second instant messaging participant system in response to a user interaction with the instant messaging application user interface (P[0021-0027], P[0046-0047], Hashemi discloses steaming clip to other peers).

As to claim 7, Hashemi teaches the method of claim 6 in which enabling user selection comprises enabling user selection of at least one of a text communications mode, an audio communications mode, a still photograph communications mode and a video communications mode (P[0021]).

As to claim 8, Hashemi teaches the method of claim 6 in which enabling creation of a message clip comprises enabling selection of a pre-stored message clip (P[0021]).

As to claim 9, Hashemi teaches the method of claim 8 wherein the pre-stored message clip is stored on a host system (P[0021]).

As to claim 10, Hashemi teaches the method of claim 6 further comprising:

selecting the first available mode (P[0021-0027]);

creating a first message clip on the first instant messaging participant system according to the first available mode (P[0021-0027]); and

delivering the first message clip from the first instant messaging participant system to the second instant messaging participant system (P[0046-0047]).



As to claim 11, Hashemi teaches the method of claim 10 further comprising:

selecting the second available mode (P[0021-0027]);

creating a second message clip on the first instant messaging participant system according to the second available mode (P[0021-0027]); and

delivering the second message clip from the first instant messaging participant system to the second instant messaging participant system (P[0046-0047]).

As to claim 12, Hashemi teaches a computer program, stored on a computer readable medium, the computer program comprising instructions for:

enabling user selection on a first instant messaging participant system of an instant messaging communications mode from among at least a first available mode and a second available mode, the first available mode disclosing a different amount of information about a first instant messaging participant than the second available mode (P[0021-0027], P[0046-0047], Fig. 2, Hashemi discloses audio and video mode);

enabling creation of a message clip on the first instant messaging participant system according to the selected communications mode (P[0021-0027], P[0046-0047], Hashemi discloses recording and storing clip); and

enabling delivery of the message clip from the first instant messaging participant system to a second instant messaging participant system (P[0021-0027], P[0046-0047], Hashemi discloses steaming clip to other peers).

As to claim 13, Hashemi teaches the computer program of claim 12 further comprising instructions for storing the message clip on a host system (P[0021]).

As to claim 14, Hashemi teaches the computer program of claim 13 wherein instructions for enabling delivery comprises instructions for enabling delivery of the message clip from the host system to the second instant messaging participant system (P[0046-0047]).

As to claim 15, Hashemi teaches the computer program of claim 12 further comprising instructions for:

selecting the first available mode (P[0021-0027]);

creating a first message clip on the first instant messaging participant system according to the first available mode (P[0021-0027]); and

delivering the first message clip from the first instant messaging participant system to the second instant messaging participant system (P[0046-0047]).

As to claim 16, Hashemi teaches the computer program of claim 15 further comprising instructions for:

selecting the second available mode (P[0021-0027]);

creating a second message clip on the first instant messaging participant system according to the second available mode (P[0021-0027]); and

delivering the second message clip from the first instant messaging participant system to the second instant messaging participant system (P[0046-0047]).

As to claim 17, Hashemi teaches a computer program, stored on a computer readable medium, the computer program comprising instructions for:

rendering, on a first instant messaging participant system, an instant messaging application user interface for an instant messaging communications session involving at least a first instant messaging participant and a second instant messaging participant (Fig. 2, P[0046-0047], Hashemi discloses chat (instant messaging) system);

enabling user selection on the first instant messaging participant system of an instant messaging communications mode from among at least a first available mode and a second available mode, the first available mode disclosing a different amount of information about the first instant messaging participant than the second available mode, the user selection being enabled at least in part through display of the available modes at the instant messaging application user interface (P[0021-0027], P[0046-0047], Fig. 2, Hashemi discloses audio and video mode);

enabling creation of a message clip on the first instant messaging participant system according to the selected communications mode, the message clip being created at least in part through user interaction with the instant messaging application user interface (P[0021-0027], P[0046-0047], Hashemi discloses recording and storing clip); and

enabling delivery of the message clip from the first instant messaging participant system to a second instant messaging participant system in response to a user interaction with the instant messaging application user interface (P[0021-0027], P[0046-0047], Hashemi discloses streaming clip to other peers).

As to claim 18, Hashemi teaches the computer program of claim 17 in which instructions for enabling user selection comprises instructions for enabling user selection of at least one of a text communications mode, an audio communications mode, a still photograph communications mode and a video communications mode (P[0021]).

As to claim 19, Hashemi teaches the computer program of claim 17 in which instructions for enabling creation of a message clip comprises instructions for enabling selection of a pre-stored message clip (P[0021]).

As to claim 20, Hashemi teaches the computer program of claim 19 wherein the message clip is stored on a host system (P[0021]).

As to claim 21, Hashemi teaches the computer program of claim 17 further comprising instructions for:

selecting the first available mode (P[0021-0027]);

creating a first message clip on the first instant messaging participant system according to the first available mode (P[0021-0027]); and

delivering the first message clip from the first instant messaging participant system to the second instant messaging participant system (P[0046-0047]).

As to claim 22, Hashemi teaches the computer program of claim 21 further comprising instructions for:

selecting the second available mode (P[0021-0027]);

creating a second message clip on the first instant messaging participant system according to the second available mode (P[0021-0027]); and

delivering the second message clip from the first instant messaging participant system to the second instant messaging participant system (P[0046-0047]).

5. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from

the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Yu et al. (U.S. Patent Number 7,058,036) discloses method for wireless instant messaging.
- England (U.S. Patent Number 6,144,991) discloses system for managing interactions between users in a browser-based telecommunications network.
- Myers et al. (U.S. patent Number 7,065,186) discloses telephone based access to instant messaging.
- Day et al. (U.S. patent Number 7,039,676) discloses using video image analysis to automatically transmit gestures over a network in a chat or instant messaging session.
- Doty, Jr. (U.S. Patent Number 6,795,863) discloses System for combining steaming video with e-mail.
- Ozkhan et al. (U.S. Patent Number 6,748,421) discloses method and system for conveying video messages.
- DeSimone et al. (U.S. Patent Number 6,212,548) discloses system for multiple asynchronous text chat conversations.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faruk Hamza whose telephone number is 571-272-7969. The examiner can normally be reached on Monday through Friday.

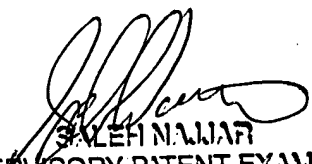
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll -free).

Faruk Hamza

Patent Examiner

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